

## **2. REMARKS / DISCUSSION OF ISSUES**

Claims 1-9, 19 and 20 are pending in the application. Claims 10-18 and 21-34 were cancelled in a previous response to a requirement of restriction.

### **Rejections under 35 U.S.C. § 102**

Claims 1-9, 19 and 20 were rejected under 35 U.S.C. § 102(a) as allegedly being unpatentable over *Kraus, Jr., et al.* (U.S. Patent 6,470,220). For at least the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the applied art.

At the outset Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim.<sup>1</sup> Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference.<sup>2</sup> Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice.<sup>3</sup> For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.<sup>4</sup>

#### **a. Claim 1**

Claim 1 recites:

*A device for determining mechanical, particularly elastic, parameters of an examination object, comprising a) at least one arrangement for determining the spatial distribution of magnetic particles in at least one examination area of the examination object, comprising*

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<sup>1</sup> See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

<sup>2</sup> See, e.g., *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).

<sup>3</sup> See, e.g., *Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992).

<sup>4</sup> See, e.g., *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

*a means for generating a magnetic field with a spatial profile of the magnetic field strength such that there is produced in at least one examination area a first part-area having a low magnetic field strength and a second part-area having a higher magnetic field strength, a means for detecting signals which depend on the magnetization in the examination object, particularly in the examination area, that is influenced by a spatial change in the particles, and a means for evaluating the signals so as to obtain information about the, in particular temporally changing, spatial distribution of the magnetic particles in the examination area; and b) at least one means for generating mechanical displacements, in particular oscillations, at least in and/or adjacent to the examination area of the examination object.*

Again,. Applicants respectfully submit that the applied art fails to disclose at least the emphasized feature of claim 1. In rejecting the emphasized portion of claim 1, the Office Action directs Applicants to “SQUID” at column 7, lines 60-67, and to col. 13, line 9 through column 14, line 25 of *Kraus, Jr., et al.* The portion of column 7 relied upon describes SQUID sensors, which are magnetometers useful in detecting extremely weak magnetic fields. The portions of column 13 and 14 relied upon describe application of time-varying spatial distribution of magnetic fields by movement of coils or by rotation of the field distribution by a set of computer controlled magnetic induction coils that are distributed and phased to produce the desired field distributions and rotational frequency. However, while phase lag of particle precession in viscous environments are described, there is no disclosure of producing *in at least one examination area a first part-area having a low magnetic field strength and a second part-area having a higher magnetic field strength*. Furthermore, while a system for conducting both treatment and temperature measurement are described including a combination of electromagnetic field-generating coils and squid devices, there remains a deficiency of producing *in at least one examination area a first part-area having a low magnetic field strength and a second part-area having a higher magnetic field strength* as is specifically recited in

claim 1. (Kindly refer to column 13, lines 10-40 and line 63-column 14, line 16 of *Kraus, Jr., et al.* for support for these assertions.)

In the Response to Arguments on page 4, the Office Action asserts (with emphasis in original):

“Examiner respectfully disagrees and points out that claim 1 includes language that modifies the aforementioned feature such that it is “influenced by a spatial change in the particles, and means for evaluating the signals so as to obtain information about the [sic], in particular temporally changing, spatial distribution of the magnetic particles in the area.” *The passage(s) in column 13-column 14 of Kraus, Jr. et al. suggest as much (such as “time varying distribution of the magnetic field (col. 13, line 9);” and “amount of magnetic material can vary depending upon the magnetic strength per unit volume” in an examination area (col. 14, ll. 31-33). Kraus, Jr. may not describe the feature in question in exactly the same words, but the teaching are there.*”

At the outset, Applicants respectfully submits that even assuming *arguendo* that the time varying distribution of the magnetic field is disclosed, the claim features *at least one examination area a first part-area having a low magnetic field strength and a second part-area having a higher magnetic field strength*. This is not disclosed in *Kraus, Jr., et al.* Specifically, the temporal variation of the magnetic field of *Kraus, Jr., et al.* has not spatial restriction. Therefore, there is no areal dependence of the magnetic field strength disclosed.

The Office Action further states:

“Furthermore, *Kraus, Jr., et al.* discusses means for producing magnetic fields so that they are different from one to the next (“alternating fields”)(col. 13, line 66)”. It would be inherent that they vary such that one field would have higher or lower in magnetic field strength than a nearby field would have.”

Column 13, line 65-column 14, line 3 of *Kraus, Jr., et al.* discloses:

“A combination of alternating fields from, e.g., multiple electromagnets, with a phase difference between the fields is designed so as to yield a rotation of the overall field upon the desired body. In effect there would be a stirring action. In this manner the magnetic material would undergo rotation within the rotating field and result in viscous heating of the medium or in this case the cellular area in the vicinity of the body whereat the magnetic material containing substance is attached.”

Thus, a rotation of the field to result in a viscous heating for treatment is disclosed, but there is no disclosure of *at least one examination area a first part-area having a low magnetic field strength and a second part-area having a higher magnetic field strength*. Rather, field rotation is disclosed.

Moreover, Applicants respectfully submit that the claim of inherency is not properly established. To this end, M.P.E.P. § 2112 IV provides that:

*EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY*

*The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “**To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference,** and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).*

(emphasis added).

Furthermore, a claim rejection must be based on objective evidence of record, and

cannot be supported merely on subjective belief and unknown authority.<sup>5</sup>

No such concrete evidence has been provided by the Examiner here, nor did the Examiner submit an affidavit as required by 37 C.F.R. § 1.104(d)(2) if this proposed motive were based on facts within his personal knowledge (see M.P.E.P. § 2144.03). Applicants respectfully request that such an affidavit be provided if a rejection continues to be made without a citation of any objective evidence.

Accordingly, and for at least the reasons set forth above, Applicants respectfully submit that *Kraus, Jr., et al.* fails to disclose at least one feature of claim 1. As such, a *prima facie* case of anticipation has not been established, and claim 1 is patentable over the *Kraus, Jr., et al.* Furthermore, claims 2-9, 19 and 20, which depend immediately or ultimately from claim 1, are patentable for at least the same reasons and in view of their additionally recited subject matter.

### **Conclusion**

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

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<sup>5</sup> See, e.g., M.P.E.P. § 2144.03; *In re Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *In re Zerko*, 258 F.3d at 1386, 59 USPQ2d at 1697.

Respectfully submitted on behalf of:  
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